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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re patent application of:	)	
	)	Before the Examiner:
Han H. Nee	)	Elizabeth Evans Mulvaney
	)	
Application No.: 10/763,697	)	
	)	Group Art Unit:
Filed: January 23, 2004	)	1774
	)	
METAL ALLOYS FOR THE REFLECTIVE OR THE SEMI-REFLECTIVE LAYER OF AN OPTICAL STORAGE MEDIUM	)	

RESPONSE TO FIRST OFFICE ACTION

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This paper is being filed as a response to a first Office Action on the merits mailed on June 20, 2004 and given a three-month shortened statutory period for reply. The instant Application is a continuation-in-part (CIP) of the Applicant's earlier issued U. S. patents 6,544,616 (issued on April 13, 2001) and 6,007,889 (issued on October 28, 1999).

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to the Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on:

Date of Deposit: August 20, 2004

Signature of Registered Representative: John J. Emanuele

The applicant believes that, as this response is being filed before expiration of the three month shorten statutory period given for reply, no additional fees are due. However, if additional fees are due the Commissioner is authorized to charge any fees that are due to Deposit Account No. 23-3030, but not to include any payment of issue fees.

All 79 pending claims were rejected. Based on the following analysis and argument the Applicant respectfully requests that all rejections be removed, and that all pending claims (1-79) be allowed.

Brief Summary of the Office Action

All pending claims (1-79) of the application were rejected for Double Patenting as defined under 35 U. S. C. § 101 over the Applicant's U. S. Patent No. 6,544,616 (the '616 patent). The only basis for the rejection is Statutory Type Double Patenting under 35 U. S. C. § 101. The Action also noted that a Double Patenting rejection based upon 35 U. S. C. § 101 cannot be cured by filing a Terminal Disclaimer.

Analysis and Argument

A Double Patenting rejection based upon statute 35 U. S. C. § 101 requires that the claimed invention and the cited art recite the same invention. The test for same invention is "whether one of the claims being compared could be literally infringed without literally infringing the other." *In re Avery*, 518 F.2d 1228 at 1232, 186 USPQ 161 at 164 (CCPA 1975). The court has recited the following test for Double Patenting holding that:

> "[a] good test, and probably the only objective test for 'same invention,' is whether one of the claims could be literally infringed without literally infringing the other. If it could be,

the claims do not define identically the same invention." *In re Vogel* 422 F.2d 438 at 441, 164 USPQ 619 at 622 (CCPA 1970).

Applying the test outlined in *Vogel* to the instant case the Applicant believes that the claims of the instant Application do not constitute Double Patenting over the claims of the Applicant's '616 patent. Both the instant Application and the "616 patent comprise 79 total claims six of which are independent claims specifically claims 1, 15, 29, 43, 57, 70. All of the independent claims of the instant Application recite the following term "semi-reflective." This term as recited in the Application's specification on, for example, page 9 lines 14-16, page 12 lines 8-12 and throughout the specification are not recited in any of the independent claims of the Applicant's '616 patent.

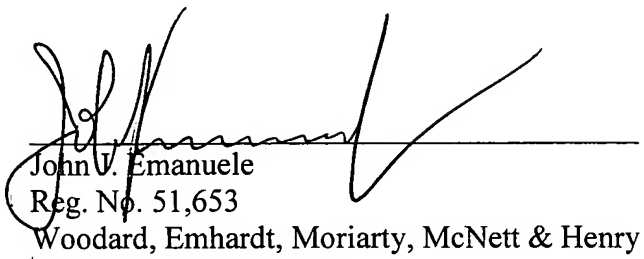
Because the scope of independent claims of the instant Application and the Applicant's '616 patent are different the claims are not identical and therefore the Double Patenting rejection based on 35 U.S.C. § 101 is invalid and should be withdrawn. Accordingly the Applicant respectfully requests that the Double Patenting rejection be withdrawn and that all pending claims be allowed.

If the Examiner removes the Double Patenting rejection and instead finds that the claims of the instant application and the '616 patent are unobvivious under the Judicially Created Doctrine of Non-Obviousness Type Double Patenting the Applicant will likely agree to file a Terminal Disclaimer. The Applicant acknowledges that by filing a Terminal Disclaimer to obviate a finding of Obviousness Type Double Patenting the term of a patent issuing from the instant application will be reduced in accordance with the specific provisions of the Terminal Disclaimer to be filled.

If there are any issues that the Examiner believes can be more readily addressed

telephonically the Applicant respectfully invites the Examiner to call the under singed agent for the Applicant.

Respectfully submitted:



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